



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 10/828,793 | 04/20/2004 | Edwin C. Iliff | ILIFF.015A6D1 | 5083 |

20995 7590 01/22/2007
KNOBBE MARTENS OLSON & BEAR LLP
2040 MAIN STREET
FOURTEENTH FLOOR
IRVINE, CA 92614

| |
|----------|
| EXAMINER |
|----------|

ZHOU, SHUBO

| | |
|----------|--------------|
| ART UNIT | PAPER NUMBER |
|----------|--------------|

1631

| SHORTENED STATUTORY PERIOD OF RESPONSE | NOTIFICATION DATE | DELIVERY MODE |
|--|-------------------|---------------|
| 31 DAYS | 01/22/2007 | ELECTRONIC |

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Notice of this Office communication was sent electronically on the above-indicated "Notification Date" and has a shortened statutory period for reply of 31 DAYS from 01/22/2007.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

jcartee@kmob.com
eOAPilot@kmob.com

Office Action Summary

Application No.

10/828,793

Applicant(s)

ILIFF, EDWIN C.

Examiner

Shubo (Joe) Zhou

Art Unit

1631

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 October 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 6-34 is/are pending in the application.
- 4a) Of the above claim(s) 9 and 22-34 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 6-8 and 10-21 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Restriction/Election Requirement

Applicant's election, with traverse, of group II (claims 5-8) in the response filed 10/24/06 is acknowledged.

The traversal is on the ground(s) that group II and group III should be examined together because there would be no search burden therefor as the groups belong to the same classification and cover the same search field. This is not found persuasive. As set forth in the previous Office action mailed 7/20/06, the inventions of groups II and III are directed to related products. However they are distinct. The system of group II comprises a plurality objects that interact, and the object contained in the system can be a valuator object, a question object, a node object or a candidate object. The system of group III, however, comprises multiple disease objects and system objects that perform their own tasks and call upon other objects to perform their tasks at the appropriate time. Thus, clearly these systems comprise different objects with distinct functions, and they do not overlap in scope, are not obvious variants, have different mode of actions, function and effect. Searching each group requires different field of such, e.g. searching of group II requiring searching a valuator object, a question object, a node object or a candidate object, which is not required for searching group III. On the other hand, searching for group III requires searching the limitation that multiple disease objects and system objects interact with each other to perform their own tasks and call upon other objects to perform their tasks at the

Art Unit: 1631

appropriate time, which is not required for group II. Thus, searches for group II and group III are not coextensive, and require different search fields.

The requirement is still deemed proper and is therefore made FINAL.

Applicant's amendments to the claims filed 10/24/06 are also acknowledged and entered, which amended claims 6 and 9, and added new claims 10-21, which depend from claim 6, directly or indirectly, and new claims 22-34, which depend from claim 9, directly or indirectly.

Claims 9 and 22-34, which belong to group III, are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 10/24/06.

It is noted that the newly added claims 10-21 of group II are directed to the following patentably distinct species with regard to the disease objects in the system:

(A) a system as in claim 6, wherein a particular disease is associated with a plurality of disease objects corresponding to different phases of the particular disease; and

(B) a system as in claim 6, wherein a particular disease is associated with a plurality of disease objects corresponding to different populations for the particular disease.

The species are distinct because they involve distinct elements and functions. Species (A) involves disease objects corresponding to different phases of the particular disease whereas species (B) involves disease objects corresponding to different populations for the particular disease. Furthermore, search of each species requires searching the different limitations as above and thus requires different search fields.

Art Unit: 1631

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species, (A) or (B) for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable.

The new claims of group II are also directed to the following patentably distinct species with regard to the relationship among the objects of the systems:

(C) a system wherein the objects act independently of other objects and a particular object retains a record of its actions for future reference, as in claim 18; and

(D) a system wherein the objects interact with each other, such as claims 12-14 and 19-21.

The species are distinct because they involve distinct functions. Species (C) requires that the objects in the system act independently, whereas species (D) requires that the objects interact. Thus, search of each species requires searching the different limitations as above and thus requires different search fields.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species, (C) or (D) for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable.

Applicant is advised that a reply to this requirement must include an identification of the species that are elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which depend from or otherwise require all the limitations of an allowable generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Because these species are independent or distinct for the reasons given above and the inventions require a different field of search (see MPEP § 808.02), restriction for examination purposes as indicated is proper.

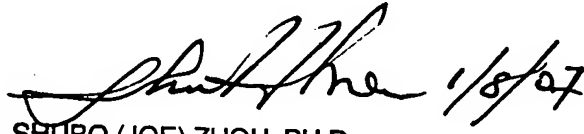
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shubo (Joe) Zhou, whose telephone number is 571-272-0724. The examiner can normally be reached Monday-Friday from 8 A.M. to 4 P.M. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Wang, can be reached on 571-272-0811. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Patent applicants with problems or questions regarding electronic images that can be viewed in the Patent Application Information Retrieval system (PAIR) can now contact the USPTO's Patent Electronic Business Center (Patent EBC) for assistance. Representatives are available to answer your questions daily from 6 am to midnight (EST). The toll free number is (866) 217-9197. When calling please have your application serial or patent number, the type of document you are having an image problem with, the number of pages and the specific nature of the problem. The Patent Electronic Business Center will notify applicants of the resolution of the problem within 5-7 business days. Applicants can also check PAIR to confirm that the problem has been corrected. The USPTO's Patent Electronic Business Center is a complete service center supporting all patent business on the Internet. The USPTO's PAIR system provides Internet-based access to patent application status and history information. It also

Art Unit: 1631

enables applicants to view the scanned images of their own application file folder(s) as well as general patent information available to the public. For all other customer support, please call the USPTO Call Center (UCC) at 800-786-9199.

sz/SZ

 1/8/07
SHUBO (JOE) ZHOU, PH.D.
PATENT EXAMINER